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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,946

06/22/2006

Yousuke Hoshi

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20457

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03/26/2008

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EXAMINER

PUTTLITZ, KARL J

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,946

Applicant(s)

HOSHI ET AL.

Examiner

KARL J. PUTTLITZ

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date various
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I claim(s) 1 and 2 drawn to a luminescence system

Group II claim(s) 3 and 4 drawn to a method of luminescence

Group III claim(s) 5-16 and 19 drawn to a chemical substance for luminescence

Group II claim(s) 3 and 4 drawn to a luminescence device

Unity exists when there is a technical relationship among the claimed inventions involving one or more corresponding special technical features. A special technical feature is a contribution which each of the inventions, considered as a whole, makes over the prior art. See M.P.E.P Appendix A1, § 206 and Annex B.

Here, the foregoing groups lack unity since the special technical features of the groups do not correspond.

During a telephone conversation with William Solomon on 3/13/2008 a provisional election was made with traverse to prosecute the invention of Group III claims 5-16 and 19. Affirmation of this election must be made by applicant in replying to

this Office action. Claims 1-4, 17 and 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

The specification is required to have a section concerning a brief description of the drawings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Meijis et al., Tetrahedron Letters (1987), 28(45), 5559-60 (Meijis)

Meijis teaches the following compound that anticipates the rejected claims:



See attached CAS online citation 109:54336 [retrieved 13 March 2008] from STN; Columbus, OH, USA. The rejected claims only cover the recited compound, notwithstanding the recitation that the compound can change into a second chemical substance having a chemical structure that is different from that of the first chemical substance and thereby luminesce.

Claims 5-12, 14 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 10061202 (DE 202)

DE 202 teaches hexadiene. The rejected claims only cover the recited compound, notwithstanding the recitation that the compound can change into a second chemical substance having a chemical structure that is different from that of the first chemical substance and thereby luminesce.

Claims 5-12, 15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bally, THEOCHEM (1991), 73, 249-64 (Bally)

Bally teaches the following compound that anticipates the rejected claims:



See attached CAS online citation 115:48440 [retrieved 13 March 2008] from STN; Columbus, OH, USA. The rejected claims only cover the recited compound, notwithstanding the recitation that the compound can change into a second chemical substance having a chemical structure that is different from that of the first chemical substance and thereby luminesce.

Claims 5-12, 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Wurster et al., Am. Chem. Soc., Div. Petrol. Chem., Preprints (1960), 5(No. 4), C49-C58 (Wurster).

Wurster teaches the following compound that anticipates the rejected claims:



See attached CAS online citation 55:121173 [retrieved 13 March 2008] from STN; Columbus, OH, USA. The rejected claims only cover the recited compound, notwithstanding the recitation that the compound can change into a second chemical substance having a chemical structure that is different from that of the first chemical substance and thereby luminesce.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-

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0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at telephone number (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karl J. Puttlitz/

Primary Examiner, Art Unit 1621